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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,674	08/19/2003	Suong-Hyu Hyon	1736-000001/REB	5762

27572 7590 11/15/2006

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/643,674

Applicant(s)

HYON ET AL.

Examiner

Susan W. Berman

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: 40-53, 84-97, 99-101, 111-118 and 128-136.
Claim(s) rejected: 12-39, 54-83, 102-110, 119-127.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached page(s).
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 11/10/05
13. ☐ Other: _____.

Susan W Berman
Primary Examiner
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Establishment of Ownership Interest

The statement filed October 16, 2006, under 37 CFR 3.37(b) signed by applicant's attorney, David L. Suter, and stating that Yoko Gen, Chief Executive Officer of BMG, Incorporated, is authorized to sign the Assignee Consent to Reissue on behalf of BMG, Inc. has been entered. The statement of Assignee Consent to filing of a Reissue Application for US Patent 6,168,626 B1 under 37 CFR 1.172 filed 08-18-2003 and signed by Yoko Gen, C.E.O., BMG, Incorporated, is now accepted.

Response to Arguments

Applicant's arguments with respect to the rejection of claims under 35 USC 112, second paragraph have been considered but are not persuasive. Applicant argues that the disclosure in column 4, lines 37-41, supports claims omitting the step of keeping the deformed state while cooling. This argument is not persuasive because the disclosure states in column 4, lines 34-37, that the article obtained by compression-deformation is "cooled and solidified while keeping the deformed state" and in lines 43-44, "Therefore, the deformed state must not be set free until solidified." The statement in column 4, lines 37-21, sets forth what would happen if the deformed state were set free before solidification. The paragraph in column 4 from line 33 to line 44 clearly states that cooling and solidifying is performed while the article is in the deformed state.

Applicant's arguments with respect to claims 45-51, 89-95, 116-117 and 133-135 are persuasive. The rejection will be withdrawn upon filing an appeal because the claims are drawn to the instantly claimed method, rather than to the products by process. These claims will be grouped with the claims said to recite allowable subject matter.

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With respect to applicant's arguments for reconsideration of the product by process claims at issue: Applicant argues that the compression-deformation step in the recited process is not taught by Sun et al and necessarily changes the structure of the final UHMWPE product. Applicant further argues that properties such as coefficient of friction or wear properties are not required to show a difference in the products obtained by compression-deformation because one skilled in the art would know that the instantly disclosed process results in different properties. These arguments are not persuasive because Sun et al discloses a method that comprises using a forming device that melts and forms the resin to produce a polymeric raw material after removing oxygen from the resin and before machining the raw material into an implant (column 4, lines 26-29, and column 5, lines 23-37). Sun et al teach that the forming process can be by compression molding under high temperature and high pressure. It is the examiner's position that the compression molding taught by Sun et al corresponds to the compression-deformation set forth in the instant claims. The difference between the method taught by Sun et al and the instantly disclosed method is that Sun et al perform compression molding before irradiation, while applicant performs compression-deformation on the irradiated UHMWPE. However, there is no evidence of record to show that the properties of the UHMWPE product formed are different because of the differences in the disclosed methods.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W. Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SB
11/8/06


Susan W Berman
Primary Examiner
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Continuation of 5. Applicant's reply has overcome the following rejection(s): rejection of claims 45-51, 89-95, 98, 116-117, 133-135 over Sun et al.